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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,800	03/24/2004	Jason Loke	KW03-001	6032
7590 11/23/2005			EXAMINER	
Stephen B. Ackerman George O. Saile & Associates 28 Davis Avenue Poughkeepsie, NY 12603			LAYNO, BENJAMIN	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 11/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/808,800

Applicant(s)

LOKE, JASON

Examiner

Benjamin H. Layno

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 5/19/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102 or § 103***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 6, 8, 9 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Marcley et al.

The patent to Marcley discloses a method of playing a word forming card game. The game comprises a deck of 208 letter playing cards 10. Thus, there are at least seventy-two cards. 26 letters of the alphabet are repeated 8 times, col. 3, lines 15-18.

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Thus, there are at least four cards each of the letter S; three cards each of the letters B, C, D, F, M, P and T; at least two cards each of the letters G, H, L, N, R and W; one card each of the letters J, K, Q, V, X, Y and Z. Marcley's deck further includes two wild cards 50, col. 3, line 59. It is inherent or obvious that the wild cards may be used to substitute any letter of the alphabet. Marcley's deck further includes special function card designation 30.

To play Marcley's game each player is dealt a twelve card hand, col. 3, lines 55-56. The remaining cards are placed face down in a draw pile, removing a card from the draw pile, and placing the card face up to start a discard pile, col. 3, lines 60-65. Each play then attempts to form a word using his/her twelve cards and using the special function card 30, col. 4, lines 1-6. During each player's turn, each player draws a card from the draw or discard pile, col. 4, lines 18-21. It is inherent or obvious that if a player cannot form a word, the player forfeits his/her turn to the next player. The next player repeats the word forming sequence of forming a word and drawing a card from the draw or discard pile. The first player who completes a last formed word by drawing from the draw pile or discard pile is considered the winner, col. 4, lines 11-13.

In regard to claim 15, in Marcley's game, if the draw pile is used up before the game ends, it would be inherent or it would have been obvious to reshuffle all cards in the discard pile and place the cards face down to form a new deck and continue playing until one of the players win.

***Claim Rejections - 35 USC § 103***

4. Claims 7, 12, 13, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marcley et al. as applied to claim 6 above, and further in view of (Zeng and Scrabble)

The patent publication application to Zeng discloses a word forming card game teaches that it is known in word forming card games that use letter cards to form words, to form words similar to the game of Scrabble, paragraph [0170].

In regard to claims 12 and 13, in the game of Scrabble it is well known to use the "S" tile to convert a previously cast word by a current player to form a plural of the cast word. Furthermore in Scrabble, it is a well known rule for an opposing player to challenge a player that placed a word, requiring the player that placed the word to state the meaning of the word. In view of such teaching, it would have been obvious to use Marcley's cards to play a game of Scrabble. The rules of using the "S" card to form plural words, and the rule allowing players to challenge would have been used.

Concerning claim 7, Zeng teaches that it is well know to vary the number of decks used to play the game depending on the number of players playing. Example, "One deck of playing cards are used for two to four players, and two are used for five or six players", paragraph [0216]. In view of such teaching, it would have been obvious to use a varying number of decks in Marcley's game depending on the number of players playing. Determining exactly how many decks are used would have been a manufacturing design choice which is always obvious in the art.

In regard to claim 14, Zeng's word forming card game uses a point system, see Zeng's cards 22-27, Fig. 1. Point are awarded to a winner that forms a single word having the highest numerical rank or point value, paragraph [0210]. In view of such teaching, it would have been obvious to modify Marcley's cards by providing point values to each of Marcley's cards, similar to Scrabble. This modification would have made Marcley's playing cards adaptable to play different word forming games that use a point system like Scrabble.

In regard to claim 16, Marcley's game limits the word size to 3 letters, 4 letters and 5 letters. Determining exactly the limit to size of the words being formed would have simply been a manufacturing design choice which is always obvious in the art. It is also well known in word forming games to limit the words, such as Scrabble to define a word category to be used, in Scrabble words found in the dictionary are acceptable, while words that are abbreviations, prefixes, suffixes, that have hypens or an apostrophe are unacceptable. Thus, determining exactly what words are acceptable in Marcley's modified game above would have simply been a manufacturing design choice which is always obvious in the art.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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6. Claims 6-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. In claim 16 the recitation "player who completes a last cast word by drawing from said draw pile or a top card from said discard pile, is considered the winner" is indefinite. The Applicant's specification only describes a winner as "Play continues until one of the players completes his/her hand and wins the game" on page 9, last two lines, and on page 8, lines 13-14. **A winner is not clearly defined.** What exactly does "players completes his/her hand" mean? Does it mean that the first player that forms a word and has no cards left wins the game? Or does it mean that the first player that forms a word, and there is no more cards in the draw pile to draw from, wins?

Claim 14 recites "merit points weighted from zero to four for each alphabet indicia". The Applicant's specification only mentions that "Each player starts the game with 30 points", and that players receive penalty points. The point total at the end of the game determines the winner, see page 5 and page 10. **There is no mention or suggestion in the specification or drawings of "merit points weighted from zero to four for each alphabet indicia".**

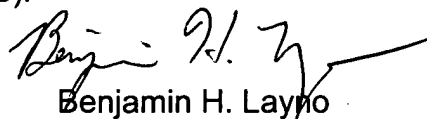
***Allowable Subject Matter***

7. Claims 10 and 11 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin H. Layno whose telephone number is (571) 272-4424. The examiner can normally be reached on Monday-Friday, 1st Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571)272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Benjamin H. Layno  
Primary Examiner  
Art Unit 3711

bhl